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REMARKS

The applicants have studied the Final Office Action dated April 4, 2006, and respectfully request entry of this amendment under the provisions of 37 C.F.R. § 1.116 in that the amendments above and remarks below place the application and claims in condition for allowance and in better form for consideration on appeal. By virtue of this amendment, claims 6 and 33 have been canceled without prejudice or disclaimer, and claim 5 is requested to be amended; thus, claims 2-5, 9-16, 32, and 34-40 are pending. Consideration and allowance of all the pending claims in view of the above amendments and the following remarks are respectfully requested.

Claims 2-6, 9-16, and 32-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Claude or Samiotes or Lindsey in view of Das et al. and further in view of Hauser. To expedite prosecution of this application, the applicants have canceled independent claims 6 and 33 without prejudice or disclaimer; however, the applicants expressly reserve the right to file a divisional application directed to this subject matter at a later date. With respect to independent claim 5 and claims 2-4, 9-16, 32, and 34-40 depending therefrom, this rejection is respectfully traversed.

Claim 5 is directed to an external infusion device that includes a housing with an opening, and a tab that is insertable into the opening in the housing and contains at least one electrical element. To further clarify the claimed invention, the applicants have amended claim 5 to recite that "the tab includes a seal to close the opening in the housing to improve resistance to water or contaminants entering the housing." The cited references in combination fail to disclose, teach, or suggest an external infusion device including such a tab, as recited in the claims. Thus, it is respectfully submitted that claim 5 and claims 2-4, 9-16, 32, and 34-40 depending therefrom are not rendered obvious by the cited references.

In the Office Action, the Examiner noted that the Claude, Samiotes, and Lindsey references do not explicitly disclose that the tab includes a seal to improve resistance to water or

contaminants entering the housing. It is respectfully submitted that the Das et al. and Hauser references do not make up for the deficiencies in the Claude, Samiotes, and Lindsey references.

The applicants respectfully point out that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of the applicants' specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. See *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984); *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. App. 1985); *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. App. 1984). Furthermore, the Federal Circuit has consistently held that hindsight reconstruction does not constitute a *prima facie* case of obviousness under 35 U.S.C. § 103. *In re Geiger*, 2 USPQ2d 1276 (Fed Cir. 1987).

The applicants respectfully submit that the cited references fail to meet this requirement for a finding of obviousness. There is no suggestion in the cited references of modifying the disclosed devices in the direction of the present invention, nor is there any suggestion whatsoever of the desirability of such modification. For example, the Examiner has not cited any suggestion in the Claude, Samiotes, or Lindsey reference to modify the disclosed devices to incorporate the seal disclosed in the Das et al. reference in order to maintain watertight properties of the pump housing. Additionally, although the Das et al. reference discloses a battery door 40 that includes a seal, the battery door 40 is internally contained within the pump casing 7, and is further protected from water or contaminants by the external pump door 36. In the Office Action, the Examiner conceded that the Das et al. reference does not disclose that the tab is insertable into the housing. Moreover, the Examiner has not pointed out any suggestion in the cited references to modify the disclosed devices to incorporate an externally accessible tab that is insertable into and closes an opening in the housing with a seal on a component internally contained within the housing. Therefore, it is respectfully submitted that the ordinarily skilled artisan would have had no motivation to provide the invention recited in claim 5.

For these reasons, the applicants respectfully submit that claim 5 and claims 2-4, 9-16, 32, and 34-40 depending therefrom are not rendered obvious by the cited references. Accordingly, withdrawal of the rejection of these claims under 35 U.S.C. § 103(a) is requested.


Claims 2-6, 9-16, and 32-40 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,752,787. In the interest of expediting prosecution of this application without prejudice, the applicants submit the enclosed Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) and authorization to charge the appropriate fee to overcome this rejection. Accordingly, it is respectfully submitted that the rejection of claims 2-6, 9-16, and 32-40 on the ground of nonstatutory obviousness-type double patenting should be withdrawn.

The applicants respectfully submit that the foregoing amendments and remarks place the application and claims in condition for allowance, and in better form for consideration on appeal. Entry of the foregoing amendments, and reexamination and reconsideration of the application, as amended, are respectfully requested.

If, for any reason, the Examiner finds that the application is other than in condition for allowance and believes that a telephone interview would advance the prosecution of the application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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